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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,018	09/19/2003	Pit Man Chiu	32159194.3	9141
23562	7590	06/28/2004	EXAMINER FERNSTROM, KURT	
BAKER & MCKENZIE PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201			ART UNIT 3712	PAPER NUMBER

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

Office Action Summary	Application No. 10/667,018	Applicant(s) CHIU ET AL.	
	Examiner Kurt Fernstrom	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
- 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
- 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/21/04</u> | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-15, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bitner. Bitner discloses a deck of playing cards comprising a plurality of cards, where the cards have visual indicia thereon. As such Bitner reads on claim 11; the remaining claim language, including the description of the object of the game in the preamble and the language concerning how the cards are "adapted" to be used is functional, describing the intended purpose of the apparatus rather than reciting further structural claims. The deck of cards of Bitner is "adapted" to be used for applicant's game because it has all of the structural limitations necessary, and thus is capable of being used in the manner contemplated by applicant. Several dependent claims, including 12, 14 15 and 20, also recite "adapted" language which is met by the deck of cards disclosed by Bitner. With respect to claim 13, Bitner discloses visual indicia comprising letters of an alphabet. With respect to claim 15, Bitner discloses in Figure 2 a wild card having a group of the visual indicia (letters) thereon. With respect to claim 19, Bitner discloses supplemental indicia corresponding to the visual indicia disposed on opposing ends of the cards and oriented as claimed to allow a person to view the indicia from either side of the card.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bitner. Bitner discloses all of the limitations of the claims with the exception of the various types of cards claimed. Again, the claim language primarily relates to the intended use of the cards, which generally is accorded little if any patentable weight. Bitner does disclose in column 3, lines 1-16 several command cards, including the "lose Your Turn" card and the "Draw" card. To the extent that the indicia recited in claims 16-18 differs from the indicia disclosed by Bitner, the claimed indicia are obvious variations relating to commands. Additionally, a claimed apparatus is not patentable over prior art where the only differences related to printed matter disposed thereon and there is not any new and unobvious functional relationship between the printed matter and the substrate. See *In re Gulack*, 217 USPQ 401 (CAFC 1983). Also, with respect to claim 17, a "misleading" command card is defined by its intended use, not by its structure, and therefore is also read on by Bitner.

Allowable Subject Matter

Claims 1-10 are allowed.

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The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest a method having all of the limitations of claim 1. In particular, there is no suggestion of having the last of the plurality of players to strike the discarded card matching the selected visual indicia. While matching games in which the object is to discard all of one's cards are known, as disclosed for example by Bitner and by other known games including Crazy Eights and Uno, the claimed method is substantially different, in that each of the players is required to strike one of the discarded cards in such a manner as to avoid being the last, and having to collect the discarded cards. There is no motivation to provide such a step in the methods of Bitner et al. As a result, claim 1, and all claims dependent therefrom, are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dwyer, Hall, Boylan, Luken, Putterman, White and Fritz disclose various card games.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
June 24, 2004

Kurt Fert
Kurt Fert